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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/632,703

08/01/2003

Gary Smith

0241-P02965US2

3628

110 7590 11/12/2009  
DANN, DORFMAN, HERRELL & SKILLMAN  
1601 MARKET STREET  
SUITE 2400  
PHILADELPHIA, PA 19103-2307

EXAMINER

CHARLES, MARCUS

ART UNIT

PAPER NUMBER

3656

MAIL DATE

DELIVERY MODE

11/12/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/632,703	<b>Applicant(s)</b> SMITH ET AL.	
	<b>Examiner</b> Marcus Charles	<b>Art Unit</b> 3656	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 August 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23, 25-35 and 37-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23, 25-35 and 37-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

This action is responsive to the submission filed 8-13-2009, which has been entered.

Claims 1-23, 25-35 and 37-47 are currently pending.

#### ***Continued Examination Under 37 CFR 1.114***

1. The request filed on 08-13-2009 for a Request for Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 10/632,703 is acceptable and a RCE has been established. An action on the RCE follows.

#### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-6, 8-23, 25-35 and 37-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP403-163245) in view of JP (04-3477043) and St. John (4,957,471). JP403-163245) discloses the claimed invention including the tensioner comprising a housing (26) with an open lower end, a base (3) with a closed end (11) closing the opened lower end of the housing, a first connector on the base (see 20/17), a shaft (13) disposed within the housing and projecting upwardly from the base and fixedly attached to the base, an arm having first and second ends with a second connector (see connection between 20 and (20/17) on the first end, a bearing (28) disposed within the housing and connected to the shaft and the housing so that the housing is rotatable relative to the base, a reversible biasing element (7) disposed in the housing and inherently providing a torque to bias the housing relative to the base in first and second

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clockwise and anticlockwise directions. It is apparent that the biasing spring is capable of being removed and diametrically replaced so that the biasing force is opposite the first biasing. JP (403-163245) is silent concerning rearranging the spring so that it biases the arm in the reverse direction. An example can be found in EP (0482382), which discloses a tensioner having a spring (40) biasing an arm (10) in a first direction (note the direction of the end of the spring engaging the post (11) in fig. 6), and the spring (150) biasing the arm (110) in a reverse direction. Therefore, the biasing element is inherently reversible. JP03-163245) does not disclose the first connector of the housing is cooperable with a second connector of the arm to attach the arm to the housing. JP (04-347043) discloses a tensioner having a housing (11) with a lower end, an arm (4) having an end with a connector (4a/5) cooperable with the connector (11b) of the housing to attach the arm to the housing. Therefore, it would be have been obvious to one of ordinary skill in the art at the time of the invention to modify the tensioner of JP403-163245) so that the arm is removable attached to the housing in view of JP (04-347043) in order to be able manipulate/adjust the arm without interfering with the housing. In addition, JP403-163245) does not disclose an indicator for indicating the direction of the biasing element. St John discloses a tensioner comprising an indicator (114 and a button on pointer 15, see attached drawing illustration) that inherently indicates the rotational movement of the arm and to indicate the amount of tension in the system and the amount of torque in the spring. If the direction of the spring is reversed, the direction of the pointer will be in the opposite towards the left or the ring of the indicator (14), thus indicating the preferred direction of the biasing forces in the relax

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state. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the device of JP403-163245) to include an indicator in view of St. John in order to indicate the amount of tension in the system and the amount of torque in the spring.

In claim 2, note the indicator is cooperable with/\* the spring to indicate the direction of the biasing force.

In claim 3, Note the indicator in capable of indicating the direction of the biasing force.

In claims 4-6, 8-22, 25-33 and 41-47, the combination of JP403-163245), JP (04-3477043) and St. John inherently indicates the claimed invention including the spring disposed in the housing (see fig. 1 of JP403-163245).

In claims 34-35 and 37-40, the method claims are inherently included during the operation of the combination of JP403-163245), JP (04-3477043) and St. John device.

### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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5. Claims 1-23, 25-35 and 37-47 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-19 of U.S. Patent No. 6,855,079 in view of St. John (4,957,471). US patent 6,855,079) discloses the claimed invention except for the indicator indicating the direction of the biasing element. St. Johns discloses a tensioner having an indicator (114), which indicates the direction amount of tensioning and the direction of tension in the system. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the tension of US patent (6,855,079) so that it includes an indicator in view of St. John for indicating the direction of the biasing element.

### ***Response to Arguments***

6. Applicant's arguments filed 8-13-2009 have been fully considered but they are not persuasive. In response to applicant argument, applicant contended that it appears the examiner misunderstood because the operation of St. John's device because the examiner maintains St. John teaches an indicator operable to indicate, which the preferred direction is. It should be noted that the claimed invention broadly claimed an indicator to indicate which direction is the preferred direction. It should be noted that the indicator of St. John is operable to indicate the direction of the arm. One of ordinary skill would be able to indicate the preferred direction base of the tensioning direction. In addition, the biasing element of St. John is a reversible biasing element and can be adjust to bias the arm in both directions. As seen in fig.7, the biasing element is mounted to a shaft via knurled area (446a). These knurled area of the shaft allows for the initial position of the arm such that the arm can be set to allow a relax position when

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the arm the indicator is directed in the middle or center of the calibration markings (see 114, in fig. 4). Figs. 7-8 clearly show the arm is in the relax state and the indicator (411a, 411b) will indicate the direction of the biasing arm. The claim does not clearly state which direction is the relax state or how the first and second direction is achieve.

In addition, applicant indicated that in St. John, the different direction can be indicated by the flipping the spring and the user would not know whether the direction will be wrapping or unwrapping. This is not so because one of ordinary skill would only flip the spring to allow the arm to be bias in the opposite direction. One direction would allow the arm to be bias to the right and by flipping the spring the arm would be biased in the opposite direction. It should be noted that the claims are so extremely broad so as to be subjected to a broad interpretation.

Regarding arguments relating to the double patenting rejection, upon further consideration it has been concluded by the examiner that the combination of Cura and St. John meet the claimed invention because of the broad recitation of the claimed invention. Therefore, for reasons given above the rejection is deemed proper.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marcus Charles whose telephone number is (571) 272-7101. The examiner can normally be reached on Monday-Thursday 7:30 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ridley Richard can be reached on (571) 272-6917. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

*Marcus Charles*

/Marcus Charles/

Primary Examiner, Art Unit 3656